

Attorney's Docket No.: 06497-013002

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : James C. Liao

Art Unit : 1652

Serial No. : 10/048,186

Examiner : Rebecca E. Prouty, Ph.D.

Filed : June 19, 2002

Title : ENGINEERING OF METABOLIC CONTROL

MAIL STOP PETITION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION REQUESTING EXAMINATION OF ALL CLAIMS IN ACCORD WITH  
UNITY OF INVENTION PRACTICE PURSUANT TO 37 C.F.R. 1.475**

Applicant petitions to withdraw the species election and subject all pending claims to examination. This is a National Phase application of PCT/US/00/20519. Examination is subject to the PCT Unity of Invention practice. See, e.g., MPEP § 802.

This petition is timely as it is being filed after a final office action, but prior to an appeal. Applicant traversed the species election made by the Action dated October 3, 2003 in the Applicant's Response dated December 3, 2004. In the remarks, Applicant emphasized that the PCT Rules do not authorize species elections made pursuant to 37 C.F.R. 1.146.

Upon entry of an Amendment mailed today with a Request for Continued Examination, claims 1, 5, 11-13, 17, 21-24, 37, 38, 40, 41, 45-50, 52-74 are pending. The Examiner has withdrawn claims 11, 22, 23, 28, 37, 38, and 46-52. Applicant is petition for examination in accord with unity of invention practice pursuant to 37 C.F.R. 1.475. Upon grant of the petition, all claims would be subject to examination.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

April 15, 2005  
Date of Deposit  
James C. Liao  
Signature  
James C. Liao  
Typed or Printed Name of Person Signing Certificate

MPEP § 801 indicates that national applications filed under 35 U.S.C. 111(a) are to be treated differently from national stage application under 35 U.S.C. 371. MPEP § 801 states in relevant part:

This chapter is limited to a discussion of the subject of restriction and double patenting under Title 35 of the United States Code and Title 37 of the Code of Federal Regulations as it relates to national applications filed under 35 U.S.C. 111(a). The discussion of unity of invention under the Patent Cooperation Treaty Articles and Rules as it is applied as an International Searching Authority, International Preliminary Examining Authority, and in applications entering the National Stage under 35 U.S.C. 371 as a Designated or Elected Office in the U.S. Patent and Trademark Office is covered in Chapter 1800.

MPEP § 802 includes the following direction:

The pertinent Patent Cooperation Treaty (PCT) Articles and Rules are cited and discussed in Chapter 1800. Sections 1850, 1875, and 1893.03(d) should be consulted for discussions on unity of invention: ...  
(C) in the National Stage under 35 U.S.C. 371. [emphasis added]

Chapter 1800 does not appear to adopt a species election practice, but instead in MPEP § 1875 directs examination according to 37 C.F.R. 1.475 for PCT National Phase application such as this one.

In particular, 37 C.F.R. 1.475 and PCT Rule 13.1 do not authorize election of a species as practice under 37 C.F.R. 1.141. These PCT rules refer to a "general inventive concept." A species is not a "general inventive concept." Examination must be consonant with the requirements of the particular rules established for PCT National Phase applications.

In this application, the Examiner has determined that claim 1 is allowable. At least claims 37, 38, and 46-74 depend directly or indirectly from claim 1. Accordingly, these claims are all within the same unity of invention concept. Claims 10 and 17 are within the same unity of invention concept as claim 1,<sup>1</sup> consistent the Examiner's position that claims 1, 10, and 17 (among others) should be examined together. Accordingly, all claims the reference back to claims 1, 10, or 17 in form or substance, i.e., all claims currently pending upon entry of the Amendment be submitted concurrently and attached herewith, should be subject to examination.

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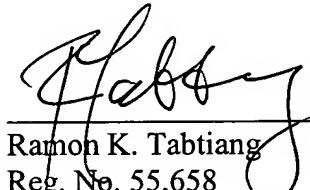
<sup>1</sup> Although the unity of invention concept in this application may not be exactly commensurate in scope with claim 1. Nor does unity of invention preclude the inventiveness of other features recited in narrower claims.

Applicant.: James C. Liao  
Serial No. : 10/048,186  
Filed : June 19, 2002  
Page : 3 of 3

Attorney's Docket No.: 06497-013002

This Petition would be mooted in the event that the Examiner rejoins and examines all claims in the Amendment being filed concurrently. Please apply any charges, including the petition fee, or credits to Deposit Account No. 06-1050.

Respectfully submitted,

  
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Date: 15 April 2005

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